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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/772,397	02/06/2004	Joan M. Cory	54644-037	5024
26633 75	90 08/03/2005		EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 1717 RHODE ISLAND AVE, NW			MANUEL, GEORGE C	
	N, DC 20036-3001		ART UNIT PAPER NUMBER	
	•		3762	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

				$ \mathcal{Q}$			
		Application No.	Applicant(s)	,			
Office Action Summary		10/772,397	CORY ET AL.				
		Examiner	Art Unit				
		George Manuel	3762				
Period fo	The MAILING DATE of this communication Reply	on appears on the cover sheet w	ith the correspondence address				
THE   - Exter after - If the - If NO - Failu Any I	ORTENED STATUTORY PERIOD FOR I MAILING DATE OF THIS COMMUNICAT asions of time may be available under the provisions of 37 SIX (6) MONTHS from the mailing date of this communica period for reply specified above is less than thirty (30) day period for reply is specified above, the maximum statutory re to reply within the set or extended period for reply will, be reply received by the Office later than three months after the patent term adjustment. See 37 CFR 1.704(b).	TION.  CFR 1.136(a). In no event, however, may a tion.  s, a reply within the statutory minimum of thi period will apply and will expire SIX (6) MOI y statute, cause the application to become A	reply be timely filed  ty (30) days will be considered timely.  NTHS from the mailing date of this communication  BANDONED (35 U.S.C. § 133).	٦.			
Status							
1)🖾	Responsive to communication(s) filed or	n 06 February 2004.					
		This action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the men							
	closed in accordance with the practice u	nder <i>Ex parte Quayle</i> , 1935 C.[	). 11, 453 O.G. 213.				
Dispositi	on of Claims						
4)🖂	Claim(s) 41-52 is/are pending in the app	lication.					
	4a) Of the above claim(s) is/are withdrawn from consideration.						
5)🖂	Claim(s) 42-46 and 48-52 is/are allowed						
6)⊠ Claim(s) <u>41 and 47</u> is/are rejected.							
7) Claim(s) is/are objected to.							
8)	Claim(s) are subject to restriction	and/or election requirement.					
Applicati	on Papers						
9)	The specification is objected to by the Ex	aminer.					
10)	The drawing(s) filed on is/are: a)[	☐ accepted or b)☐ objected to	by the Examiner.				
	Applicant may not request that any objection	to the drawing(s) be held in abeya	nce. See 37 CFR 1.85(a).				
	Replacement drawing sheet(s) including the	· ·		1).			
11)	The oath or declaration is objected to by	the Examiner. Note the attache	d Office Action or form PTO-152.				
Priority ι	ınder 35 U.S.C. § 119	•					
a)(	Acknowledgment is made of a claim for for All b) Some * c) None of:  1. Certified copies of the priority documents of the priority documents. Copies of the priority documents of the certified copies of the application from the International Englishments.	uments have been received. uments have been received in A e priority documents have beer Bureau (PCT Rule 17.2(a)).	Application No I received in this National Stage				
Attachmen		<b>∧</b> □ 1-4	Currence (DTO 442)				
	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-9	48) Paper No	Summary (PTO-413) s)/Mail Date				
3) 🛛 Inform	nation Disclosure Statement(s) (PTO-1449 or PTO r No(s)/Mail Date <u>2/6/04</u> .		nformal Patent Application (PTO-152)				

Application/Control Number: 10/772,397

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#### **DETAILED** ACTION

## **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37. CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Patent No. 6,706,016. Although the conflicting claims are not identical, they are not patentably distinct from each other because depth measurement marks are an obvious variation of resistive layer changes since both allow a user to measure needle depth.

#### Allowable Subject Matter

Claims 42-46 and 48-52 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: A variable control mechanism comprising a variable optical switching device to

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control the amplitude of an application of electric current in a nerve stimulator needle as claimed does not appear to be suggested or rendered obvious by the prior art of record.

## Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Tassel et al '309 disclose measuring the depth for a catheter comprising marks on a tubular member for insertion into a patient's skin; however, there lacks a teaching or suggestion to combine the depth measurement marks with a nerve stimulator needle for applying electric current.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.

George Manuel Primary Examiner

8/1/05